



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,379	04/13/2004	Carl E. Whitcomb	WHIT/0019.A	3362

24945 7590 03/14/2008
STREETS & STEELE
13831 NORTHWEST FREEWAY
SUITE 355
HOUSTON, TX 77040

EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
----------	--------------

3643

MAIL DATE	DELIVERY MODE
-----------	---------------

03/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,379	Applicant(s) WHITCOMB, CARL E.	
	Examiner Son T. Nguyen	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 25,30,39,42-59 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,26-29,31-38,40-41,60-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Board of Appeal decision filed on 11/19/07, PROSECUTION IS HEREBY REOPENED. The new rejection is as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Director of Technology Center 3600 has approved of reopening prosecution by signing below:

/Donald T. Hajec/

Director, Technology Center 3600

2. Claims 25,30,39,42-59 remain withdrawn. Claims 1-24,26-29,31-38,40-41,61 have been reversed by the Board in the decision mailed on 11/19/07, which these claims have been reopened in view of a new prior art as explained below. Claims 60,62,63 have been affirmed by the Board in the decision mailed on 11/19/07. Since

claim 61 is reversed and claim 61 depends on claim 60, claim 60 will be reopened for the purpose of claim 61 only. Claims 60,62,63 are still affirmed with Single in view of Waterer.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 17,18,31-35,41** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 17, the phrase "the convex face" lacks prior antecedent basis.

For claim 18, the phrase "the convex face" lacks prior antecedent basis.

For claim 31, the phrases "the center of the proximal opening", "the center of the distal opening", and "the panel" lack prior antecedent basis.

For claim 32, the phrase "the proximal opening" lack prior antecedent basis.

For claim 41, the phrases "the proximal opening" and "the distal opening" lack prior antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1,2,5,6,8-24,29,36-38,40,41,60,61** are rejected under 35 U.S.C. 102(b) as being anticipated by Coplen (2818681).

For claim 1, Coplen teaches in figs. 3-5, a plant container, comprising: a sidewall 1 having a plurality of shoulders 9,10,2,21,20; and a base 15 supported on the shoulders, the base having an upwardly facing surface (see fig. 3) with a plurality of radially directed channels (created between grooves 19 or grooves 19 themselves can be considered channels).

For claim 2, Coplen further teaches wherein the sidewall and the base are separable. Col. 3, lines 57-63.

For claim 5, Coplen further teaches wherein the upwardly facing surface is convex. See fig. 3, self explanatory.

For claim 6, Coplen further teaches wherein the convex surface has a shape selected from conical, semispherical, elliptical, and irregular. See fig. 3, self explanatory.

For claim 8, Coplen further teaches wherein the convex surface has a shape comprising a central arch (fig. 3, where ref. 15 is pointing at) and a surrounding semispherical region (see fig. 4 the perimeter where refs. 17 & 16 are pointing at).

For claim 9, Coplen further teaches wherein the upwardly facing surface has a center (fig. 3, where ref. 15 is pointing at) and a perimeter (fig. 4, where refs. 16 & 17 are pointing at), and wherein the channels extend over more than half the distance between the center and the perimeter (see fig. 4).

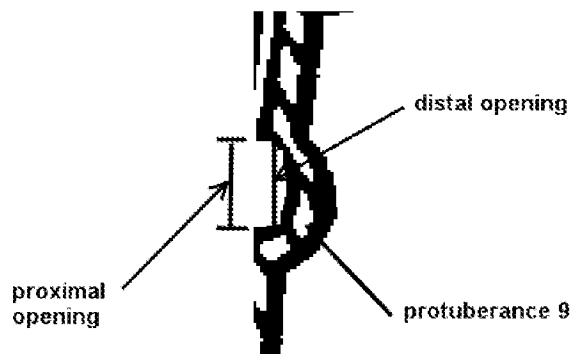
For claim 10, Coplen further teaches wherein the plurality of shoulders are inwardly extending, outwardly extending, or combinations thereof. See fig. 5 for a close up view of the shoulders.

For claim 11, Coplen further teaches wherein the base has a generally circular perimeter. See fig. 4.

For claim 12, Coplen further teaches wherein the perimeter of the generally circular base has a plurality of projections 16.

For claim 13, Coplen further teaches wherein the plurality of shoulders are provided by a plurality of protuberances 9 (see fig. 5 for close up).

For claim 14, Coplen further teaches wherein the plurality of protuberances have a proximal opening (at the entrance of the protuberance 9, the opening entrance is considered proximal opening and at almost the end of the protuberance but not quite near the wall, is the distal opening) in communication with a distal opening. See illustration below.



For claim 15, Coplen further teaches wherein the base has a perimeter with a plurality of projections 16 that extend into the plurality of protuberances 9 through the proximal openings (as shown above, the entrance opening into protuberance 9).

For claim 16, Coplen further teaches wherein the proximal openings are larger than the distal openings. See illustration above, the entrance opening into the protuberance is larger than the distal opening at almost the end of the protuberance.

For claim 17, Coplen further teaches wherein the convex face has a shape selected from conical, elliptical, semi-spherical, and irregular. See fig. 3, self explanatory.

For claim 18, Coplen further teaches wherein the convex face has an irregular shape (see fig. 4 for the irregularity) comprising a central arch (FIG. 3, where ref. 15 is pointing at) and a surrounding semi-spherical (see fig. 4) or frustoconical region.

For claim 19, Coplen further teaches wherein the channels extend over more than half the distance from the center of the base to the perimeter of the base. See fig. 4.

For claim 20, Coplen further teaches wherein the channels are disposed to direct roots toward the plurality of protuberances. Although for drainage and reinforcement, these channels can function also to direct roots toward the edge.

For claim 21, Coplen further teaches wherein each channel has a sidewall (from the groove 19 or the grooves themselves since a groove has sidewalls on each side to create the groove) that directs roots toward an individual protuberance. Although for

drainage and reinforcement, these channels can function also to direct roots toward the edge.

For claim 22, Coplen further teaches wherein the channels extend into the proximal openings of the protuberances. See fig. 5.

For claim 23, Coplen further teaches wherein the channels have a distal end with a deflecting curve 17.

For claim 24, Coplen further teaches wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders on each side of the container.

For claim 29, Coplen further teaches a central dome (at ref. 15) directing roots outwardly (inherent due to the convex shape of the dome).

For claim 36, Coplen further teaches wherein the channels are disposed to direct roots toward the plurality of protuberances. Although for drainage and reinforcement, these channels can function also to direct roots toward the edge.

For claim 37, Coplen further teaches wherein each channel has a sidewall (from the groove 19 or the grooves themselves since a groove has sidewalls on each side to create the groove) that directs roots toward an individual protuberance 9.

For claim 38, Coplen further teaches wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders on each side of the container.

For claim 40, Coplen further teaches wherein the plurality of protuberances have a lower profile with a substantially horizontal region that receives the projections. See fig. 5 for a close up of the lower profile where ref. 15 rests thereon.

For claim 41, Coplen further teaches wherein the proximal opening is larger than the distal opening. See claim 14 and illustration above for explanation.

For claim 60, Coplen teaches a plant container comprising: a container sidewall 1; and a base 15 secured to the container sidewall, the base having an upwardly facing surface (fig. 3 where ref. 15 is pointing at) with a plurality of radially directed channels (created between grooves 19 or grooves 19 themselves can be considered channels).

For claim 61, Coplen further teaches wherein the base has protrusions (see fig. 5) received within recesses 9 in the container sidewall.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-24,26-29,31-38,40,41,60,61** are rejected under 35 U.S.C. 103(a) as being unpatentable over Single (6862840) in view of Coplen (as above).

For claim 1, Single teaches a plant container 110, comprising: a sidewall having a plurality of shoulders 56 (see fig. 5); and a base 68 supported on the shoulders. However, Single is silent about the base having an upwardly facing surface with a plurality of radially directed channels.

As mentioned above, Coplen teaches the base with upwardly facing surface and plurality of radially directed channels placed in a container for elimination of excess moisture and to increase the rigidity of the base (col. 3, lines 30-49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an upwardly facing surface and plurality of radially directed channels as taught by Coplen in the base of Single, since applying this known method/apparatus of enhancement to a "base" device (automated egg injection machine) would have been predictable in order to eliminate excess moisture and to increase the rigidity of the base. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 2, both Single and Coplen teach wherein the sidewall and the base are separable, hence, the combination of both teaches the same.

For claim 3, Single as modified by Coplen (emphasis on Single) further teaches wherein the sidewall is a flexible panel that is bent and fastened in a closed curvilinear shape. See figs. 1-2, although these two figures show a different embodiment, the flexible panels for figs. 1-2 and fig. 5 are the same.

For claim 4, Single as modified by Coplen (emphasis on Single) further teaches wherein fastening the panel around the base constrains displacement" of the base. See figs. 1-2, although these two figures show a different embodiment, the flexible panels for figs. 1-2 and fig. 5 are the same.

For claims 5 & 6 , in addition to the above, Coplen's upwardly facing surface is convex having the shape of a semisphere. It would have been obvious to one having

Art Unit: 3600

ordinary skill in the art at the time the invention was made to include an upwardly facing surface that is convex having the shape of a semisphere as further taught by Coplen in the base of Single, since applying this known method/apparatus of enhancement to a "base" device (automated egg injection machine) would have been predictable in order to eliminate excess moisture and to increase the rigidity of the base. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 7, in addition to the above, Coplen further teaches the convex surface has a perimeter and a center (see above for explanation). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the convex surface with a perimeter and a center as further taught by Coplen in the base of Single, since applying this known method/apparatus of enhancement to a "base" device (automated egg injection machine) would have been predictable in order to eliminate excess moisture and to increase the rigidity of the base. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007). However, the combination of Single as modified by Coplen is silent about the convex surface has a perimeter and a center that is between 1 and 2 inches higher than the perimeter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the convex surface of the base of Single as modified by Coplen with a perimeter and a center that is between 1 and 2 inches higher than the perimeter, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

For claim 8, in addition to the above, Coplen's convex surface has a shape comprising a central arch and a surrounding semispherical region. See above of Coplen in the 102 rejection for explanation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the convex surface with central arch and a surrounding semispherical region as further taught by Coplen in the base of Single, since applying this known method/apparatus of enhancement to a "base" device (automated egg injection machine) would have been predictable in order to eliminate excess moisture and to increase the rigidity of the base. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 9, in addition to the above, Coplen's upwardly facing surface has a center and a perimeter, and wherein the channels extend over more than half the distance between the center and the perimeter (as explained in the 102 rejection above anticipated by Coplen). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the upwardly facing surface with a center and a perimeter, and wherein the channels extend over more than half the distance between the center and the perimeter as further taught by Coplen in the base of Single, since applying this known method/apparatus of enhancement to a "base" device (automated egg injection machine) would have been predictable in order to eliminate excess moisture and to increase the rigidity of the base. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 10, Single as modified by Coplen (emphasis on Single) further teaches wherein the plurality of shoulders are inwardly extending, outwardly extending, or combinations thereof. See fig. 5, self explanatory.

For claim 11, both Single and Coplen teach wherein the base has a generally circular perimeter, hence, the combination of the two teaches the same.

For claim 12, in addition to the above, Coplen further teaches wherein the perimeter of the generally circular base has a plurality of projections to hold the base within the protuberance 9 of the container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plurality of projections as further taught by Coplen in the base of Single as modified by Coplen in order to provide an attachment area between the base and the container. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

For claim 13, Single as modified by Coplen (emphasis on Single) further teaches wherein the plurality of shoulders are provided by a plurality of protuberances 72.

For claim 14, Single as modified by Coplen (emphasis on Single) further teaches wherein the plurality of protuberances have a proximal opening 38 in communication with a distal opening 40.

For claim 15, the combination of Single as modified by Coplen teaches wherein the base has a perimeter with a plurality of projections (taught by Coplen) that extend into the plurality of protuberances (taught by Single) through the proximal openings (taught by Single).

For claim 16, Single as modified by Coplen (emphasis on Single) further teaches wherein the proximal openings are larger than the distal openings. See fig. 5.

For claims 17-19, the limitation has been discussed in the above, thus, please see teaching above of Single as modified by Coplen.

For claim 20, the combination of Single as modified by Coplen would teach the channels (taught by Coplen) are disposed to direct roots toward the plurality of protuberances (taught by Single). See also comment above in the 102 rejection anticipated by Coplen.

For claim 21, the combination of Single as modified by Coplen would teach each channel (taught by Coplen) has a sidewall that directs roots toward an individual protuberance (taught by Single). See also comment above in the 102 rejection anticipated by Coplen.

For claim 22, the combination of Single as modified by Coplen would teach the channels (taught by Coplen) extend into the proximal openings of the protuberances (Single).

For claim 23, the combination of Single as modified by Coplen would teach wherein the channels (taught by Coplen) have a distal end with a deflecting curve. See also comment above in the 102 rejection anticipated by Coplen.

For claim 24, Single as modified by Coplen (emphasis on Single) further teaches wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders. See fig. 5.

For claims 26-28, Single as modified by Coplen is silent about wherein the channels are between 0.1 and 1 inches tall, 0.15 and 0.75 inches tall, or 0.25 and 0.5 inches tall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the channels of Single as modified by Coplen be between 0.1 and 1 inches tall, 0.15 and 0.75 inches tall, or 0.25 and 0.5 inches tall, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 29, the combination of Single as modified by Coplen would teach a central dome directing roots outwardly (taught by Coplen). See also comment above in the 102 rejection anticipated by Coplen.

For claim 31, Single as modified by Coplen is silent about wherein the center of the proximal opening is positioned higher than the center of the distal opening when the panel is positioned upright. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the center of the proximal opening is positioned higher than the center of the distal opening when the panel is positioned upright in the plant container of Single as modified by Coplen, depending on the user's preference in designing the container. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007). Note that Applicant has multiple embodiments of the sidewall of the container. However, the position of the openings appear to not be critical because Applicant fails to define such criticality (see paragraph [0041] of Applicant's PGPUB). In this paragraph, Applicant only states it is

"optional" to have the proximal opening is positioned higher than the center of the distal opening when the panel is positioned upright, thus, there is no criticality except that it is a personal preference to make the sidewall with variation.

For claim 32, the combination of Single as modified would teach the perimeter of the base has a plurality of projections (taught by Coplen) that extend into the plurality of protuberances (taught by Single) through the proximal opening.

For claims 33-41,60-61, the limitations in these claims have been discussed in the above, thus, please see above.

9. **Claims 7,26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coplen (as above).

For claim 7, Coplen is silent about wherein the convex surface has a perimeter and a center that is between 1 and 2 inches higher than the perimeter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the convex surface of Coplen with a perimeter and a center that is between 1 and 2 inches higher than the perimeter, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claims 26-28, Coplen is silent about wherein the channels are between 0.1 and 1 inches tall, 0.15 and 0.75 inches tall, or 0.25 and 0.5 inches tall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the channels of Coplen be between 0.1 and 1 inches tall, 0.15 and 0.75 inches

Art Unit: 3600

tall, or 0.25 and 0.5 inches tall, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

10. Applicant's previous arguments against Single as modified by Waterer are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Application/Control Number: 10/823,379

Page 17

Art Unit: 3600

Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son T. Nguyen/

Primary Examiner, Art Unit 3643